

**I. THE PROPOSED MODIFICATION WOULD CHANGE THE PRINCIPLE
OF OPERATION OF NOGUCHI AND RENDER NOGUCHI'S DEVICE
UNSATISFACTORY FOR ITS INTENDED PURPOSE**

Applicant respectfully submits that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (See *In re Ratti*, 270 F.2d 810 (CCPA 1959); and MPEP §2144.01.) The applied references are not sufficient to render the claims obvious because any proposed modification of Noguchi to derive the claimed features would change the principle of operation of Noguchi. In particular, Noguchi discloses an oil passage that is used to control both the piston 60 and the rotation of the applied rotors 18 and 20. (See, for example, col. 5, lines 35-37; and col. 6, lines 47-50 of Noguchi). As shown in Figure 2 of Noguchi, the passage 50 communicates with the piston 60 and the chamber 38b. Also, the passages 54a and 62 communicate with the area between the piston 60 and the chamber 38a. If one were to modify the passage 50 to independently communicate with the piston 60, then the required fluid flow from the passage 50 to the chamber 38b, via the passage 56, would be eliminated. This would change the principle of operation in Noguchi, and would result in no fluid being provided to the chamber 38b. Therefore, not only would the principle of operation change, but Noguchi would also be rendered unsatisfactory for its intended purpose, which further evidences the lack of motivation to combine the references. (See MPEP §2143.01.) Such a modification is clearly not intended by Noguchi, nor Fujiwaki or Mikame. It

is therefore emphasized that the references are not properly combinable to render the claims obvious.

II. MODIFICATION NECESSARY TO MODIFY REFERENCES NOT TAUGHT OR SUGGESTED

A modification necessary to alter Noguchi to include the claimed feature is neither taught nor suggested. Rejections under 35 U.S.C. §103 should include:

(1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;

(2) the difference or differences in the claim over the applied reference(s);

(3) *the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter*; and

(4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

See MPEP §706.02(j).

It is respectfully submitted that, at least, requirement (3) is missing because the proposed modification necessary to arrive at the claimed subject matter is not disclosed in the references or set forth in the Office Action. In particular, the Office Action does not set forth any actual modifications that would be needed to arrive at the claimed invention. Instead, the grounds of rejection state that one would have been motivated to modify Noguchi to “provide a separate hydraulic pressure means for controlling the locking device.” However, the necessary modifications are not provided in the rejection, nor do the applied references teach or suggest

how such modifications would be accomplished. If the Examiner wishes to maintain such a rejection, it is respectfully requested that the proposed modification (i.e., what part of Noguchi is contended to be modified and how it is modified, be set forth while not relying on Applicant's disclosure.

III. OVERALL LACK OF MOTIVATION TO COMBINE THE REFERENCES

The claims provide novel combinations of elements that are neither disclosed nor obvious in view of the applied references. In an effort to expedite prosecution, claims 1 and 10 were previously amended to describe an oil passage which supplies hydraulic pressure for the closing member and is controlled separately from an oil passage which supplies hydraulic pressure for relatively rotating the first rotor and the second rotor. The Examiner acknowledges that Noguchi does not disclose these features and therefore cites Fujiwaki and Mikame.

One would not have been motivated to alter Noguchi to include an oil passage which supplies hydraulic pressure for the closing member (piston) 60 of Noguchi and which is controlled separately from an oil passage which supplies hydraulic pressure for relatively rotating the applied first rotor 18 and the second rotor 22. Obviousness cannot be established by simply combining the references, absent a proper suggestion or teaching within the references supporting the combination. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). Here, the Examiner's motivation is to "provide a separate hydraulic pressure means for controlling the locking device and therefore be free of the pressure fluctuations that may occur during advancing and retarding operations."

First, Applicant respectfully submits that alleged motivation 1) paraphrases the claimed features; and 2) repeats a portion of the present specification that indicates a problem solved by the present invention (see the present specification, page 20, last paragraph). Thus, the Examiner's alleged motivation for combining the references appears to be based, not on knowledge generally available from the prior art, but rather, on Applicant's own disclosure of problems existing in the prior art devices and the Applicant's solution thereof. This does not form the basis for proper motivation.

CONCLUSION

Applicant believes that it will be found evident that claims 1 and 10 are not obvious in view of the prior art, such that the rejection of claims 1 and 10 under 35 U.S.C. § 103(a) should be withdrawn. Dependent claims 3, 5, 6, 8, 9 and 16-19 also are not rendered obvious, at least by virtue of their respective dependencies on independent claims 1 and 10.

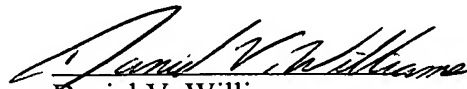
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
Appln. No.: 10/642,590

Attorney Docket No.: Q76939

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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